

DOCKET NO.: 212527US0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

GROUP: 1611

Pascal ARNAUD

SERIAL NO: 09/941,869

EXAMINER: Yu, Gina C.

FILED: August 30, 2001

FOR: TRANSFER-RESISTANT COSMETIC COMPOSITIONS COMPRISING A
NON-VOLATILE SILICONE COMPOUND, A NON-VOLATILE
HYDROCARBON-BASED OIL, AND AN INERT PARTICULAR PHASE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
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A NON-VOLATILE HYDROCARBON-BASED OIL,
AND AN INERT PARTICULAR PHASE

ATTACHMENT IN SUPPORT OF REQUEST FOR PRE-APPEAL REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313

SIR:

The Office Action rejected the pending claims as obvious over U.S. patent 5,738,841 (“Mellul”) in view of EP 548694 (“Nojima”), alone or in combination with U.S. patent 5,690,918 (“Jacks”) (claims 2-4, 11-19, 21-27, 36, 64, 71, 72, 74-78 and 84) or JP 63119412 (“JP 412”) (claims 20 and 73). The Examiner based these rejections upon the assertion that Nojima would motivate one of ordinary skill in the art to refrain from adding volatile oils to lipstick formulations, and upon the assertion/belief that Nojima’s disclosure would not lead one of ordinary skill in the art to add an alkoxylated silicone to Mellul’s compositions. These assertions, and the rejections based upon these assertions, constitute legal error and should be reconsidered and withdrawn.

The pending claims exclude the presence of alkoxyated silicones. Thus, applied art which would lead one of ordinary skill in the art to add alkoxyated silicones to a composition cannot teach or suggest the present invention.

Nojima discloses transfer-resistant compositions lacking volatile oil. Nojima is able to prepare such by requiring the presence of specified alkoxyated silicones -- more specifically, at page 4, lines 21-24, Nojima states that the benefit of “prolonged beautiful effect of the makeup” can be achieved only when the alkoxyated silicone contains 1-50% alkoxylation (according to Nojima, alkoxylation outside of this range does not yield the “prolonged beautiful effect”). Thus, Nojima teaches that if one of ordinary skill in the art wants to prepare a transfer-resistant composition lacking volatile oil, he **must** add a specified alkoxyated silicone to the composition. In other words, Nojima would not have, and could not have, motivated one of ordinary skill in the art to produce the claimed compositions having both (1) little or no volatile oil; and (2) no alkoxyated silicone compound -- according to the teachings of Nojima, compositions either had to have one or the other.

Because Nojima would lead one of ordinary skill in the art to necessarily add alkoxyated silicones, this reference cannot motivate one of ordinary skill in the art to refrain from adding volatile oils to lipstick formulations which also lack alkoxyated silicones.

The combination of Nojima with Mellul would necessarily result in a composition containing an alkoxyated, non-volatile silicone compound given Nojima’s teachings. In sharp contrast, all of the pending claims exclude the presence of such alkoxyated, non-volatile silicone compounds. For at least this reason, the

combination of Nojima and Mellul does not set forth a *prima facie* case of obviousness.

Neither Jacks nor JP 412 suggests modifying Nojima's and/or Mellul's compositions to yield the claimed invention.

Regarding Jacks, Jacks relates to transfer-resistant compositions, and typically in such compositions volatile oil evaporates after application to form a transfer-resistant film. Jacks recognizes this crucial role of volatile oils in his transfer-resistant compositions, stating that volatile oils contribute to the "wear characteristics" of his compositions. (Col. 4, lines 10-11). This is presumably why Jacks teaches and exemplifies that substantial amounts of volatile oil should be present in his compositions, most preferably between 40-50%. (Col. 4, line 38).

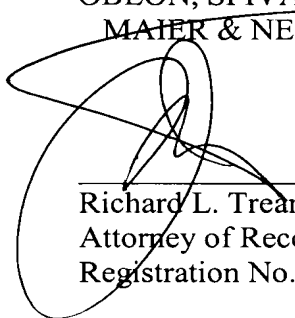
One of the practical differences between the claimed invention and Jacks is that the claimed invention permits formation of a transfer-resistant film using a composition containing little or no volatile oil, whereas Jacks requires the presence of a substantial amount of volatile oil. One of ordinary skill in the art, seeking to create a transfer-resistant film, would not be motivated by Jacks to remove or reduce volatile solvent because removing volatile solvent would affect the wear-characteristics of these transfer-resistant products. In other words, Jacks would lead one skilled in the art away from the claimed invention.

JP 412, which is cited merely for its disclosure relating to 12-hydroxystearic acids, cannot compensate for Nojima's and/or Mellul's deficiencies as well.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 based upon Nojima, Mellul, Jacks and JP 412.

Respectfully submitted,

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